



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

TH

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/593,993	06/14/2000	Roy Shkedi	JMB-2-0005	8221

7590 01/03/2003

Jay F Moldovanyi Esq  
Fay Sharpe Fagan Minnich & McKee LLP  
1100 Superior Avenue  
7th Floor  
Cleveland, OH 44114-2518

EXAMINER

STEWART, THEOPLIS E

ART UNIT	PAPER NUMBER
----------	--------------

3629

DATE MAILED: 01/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/593,993

Applicant(s)

SHKEDI, ROY

Examiner

Theoplis E Stewart

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 3629

### ***Detailed Action***

#### ***Drawings***

1. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81. No new matter may be introduced in the required drawing. Submitted drawing offers no further understanding of invention as is.

#### ***Claim Rejections - 35 USC § 101***

2.0. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2-1. The claimed invention is primarily conceptual and lacks technological details. For example: receiving, searching, and contracting as applied in claimed steps do not necessarily require a computer or computer network implementation to accomplish applicant's objective. These same steps can equally be executed via manual intervention.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Art Unit: 3629

3.0 Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Katz et al (6,055,513).

3.1. Regarding claim 1, 11, 12, and 13;

Katz discloses a descriptive-profile mercantile method, for use at a juncture in a data-communications topology having associated therewith a maintained databank of partial profiles, the method including the steps of

- receiving a transaction having therein a first partial profile; (Column 28, lines 11-14, "obtaining primary transaction data with respect to the primary transaction, including the identity of the prospective customer and of the good or service for purchase in the primary transaction,") Whereas obtaining primary transaction data is receiving a transaction of profile data.
- searching a databank having a plurality of second partial profiles, wherein is included in said databank at least one null profile so that said searching will always yield at least one proximate second partial profile to the first partial profile; (Column 28, lines 11-14, "obtaining primary transaction data with respect to the primary transaction, including the identity of the prospective customer and of the good or service for purchase in the primary transaction,") Whereas the process identity of prospective customer step is similar to searching profiles on a databank.
- contracting for the databank to own or represent a right to a first mutually agreed portion of the first partial profile, and substantially thereafter said databank incorporating the agreed portion of the first profile into at least one second partial profile; (Column 28, lines 17-28, "utilizing the identity of the prospective customer to obtain at least a second data element relating to the user, utilizing at least in part the primary transaction data including the identity of the good or service of the primary transaction and the second data element and determining at least one item for a prospective upsell transaction with the prospective customer, and offering the item to the prospective customer and receiving an acceptance of the offer from at least one user in real time during the course of the user initiated communication. ") Whereas primary data has been identified, and the gaining access to secondary data on an user to then enter into a purchase offer and acceptance. The steps in this process are known by both entities.
- contracting for the user to own or represent a right to a second mutually agreed portion of at least one said proximate second partial profile, and substantially thereafter the databank transmitting to the user the second mutually agreed portion of the second profile. (Column 28, lines 17-28, "utilizing the identity of the prospective customer to obtain at least a second data element relating to the user, utilizing at least in part the primary transaction data including the identity of the good or service of the primary transaction and the second data element and determining at least one item for a prospective upsell transaction with the prospective customer, and offering the item to the prospective customer and receiving an acceptance of the offer from at least one user in real time during the course of the user initiated communication. ") Whereas after a

Art Unit: 3629

purchase of a product secondary data has been provided to complete the sale of a product. It is common for an user in the electronic marketplace to provide additional data to complete a sale. This is a mutually agreed upon transaction.

3-2. Regarding claim 2;

Katz further discloses:

- receiving a transaction includes extracting at least one predetermined key portion of the first partial profile, wherein at least one of these extracted predetermined key portions is then used as the first partial profile for the searching of the databank. (Column 26, lines 13-17, "Upon receiving an initial contact, the transaction type may be determined at step. Various identification determinations may be collected and then used in determining whether any limitations are to be applied.)

3-3. Regarding claim 3;

Katz further discloses:

- extracting includes constructing at least one composite key for the searching of the databank using a combinatorial of at least two of the predetermined key portions of the first partial profile. (Column 17, lines 48-60, "ANI data, which may be utilized by the control unit 100 to retrieve information from the database particular to the customer. In addition to database 98, geographic designator programs exist which may be utilized to receive ANI data and to identify the geographic location of a customer such as by zip code, or more particularly, by zip code plus four. Based upon the retrieved information as provided to the live operator, a dialog is conducted relating to the primary transaction for which the customer made the primary or initial contact with the system. While handling the primary transaction, the system may access one or more databases, such as a credit database and a inventory database.") Whereas ANI data is captured and stored in a database for future use to identify a customer profile.

3-4. Regarding claim 4;

Katz further discloses:

- contracting includes selecting a pricing structure according to a rating of the user. (Column 13, lines 41-46, "The term "upsell" means an offer or provision of a good or service which is selected for offer to the customer and differs from the good or service for which the primary contact was made. The term "upsell" is not limited to the context in which a primary transaction is intended to be a sales transaction, but additionally includes the offer of a good or service offered in accordance with the selection criteria of the invention even if the primary transaction is not principally sales motivated,") Throughout the specification of this Katz, the term upsell is used to imply further action is taken electronically to the databases, and further communication (offers) takes place with call of which is initiate by profile data already obtained in the database. An offer (agreement) is presented to the call to based on secondary data obtained on the call to

Art Unit: 3629

establish a sell. This would include establishing a price structure possibly offered to only to callers within a certain profile.

3-5. Regarding claim 5;

Katz further discloses:

- contracting a right includes accepting an obligation to pay for substantially each use or transfer of the agreed portion. (Column 2, lines 41-49, "the caller may be prompted to enter an item number for purchase, utilizing an item number designation from the catalog or otherwise interact with the system to identify the good or service desired. Provision is made for user entry of payment information, such as the entry of a credit card number and type identifier") This step obligates the user to pay for product and service.

3-6. Regarding claim 6;

Katz further discloses:

- incorporating the agreed portion includes assigning a credibility weighting to the agreed portion of the first profile. (Column 9, lines 23-27, "Yet another aspect of primary transaction data may include customer identification data. Such data may be specific data in that it uniquely identifies the contact, such as in person specific data comprising an electronic address, an e-mail address, customer number, billing data or credit card number.") Whereas the plurality of personal data provides a level of credibility and places additional emphasis to the agreement.

3-7. Regarding claim 7;

Katz further discloses:

- incorporating includes convoluting the assigned credibility weighting of the first profile with a pre-existing credibility weighting of a substantially like agreed portion of a proximate second probe; and storing the convoluted new credibility weighting for the agreed portion in the databank. (Column 9, lines 57-62, "The collection of input information for the system may be effected based upon local resident databases, such as a telemarketer's database, or through use of third party databases, such as credit card or credit worthiness databases, or possibly, a combination of both local and remote databases.") Whereas the combination of data from different databases are assigned credible weight between profiles. The combined data form a new set of credible information on an user.

3-8. Regarding claim 8;

Art Unit: 3629

Katz further discloses:

- contracting includes selecting a pricing structure according to a result of a computation comparing the new credibility weighting with the pre-existing credibility weighting.

3-9. Regarding claim 9;

Katz further discloses:

- receiving a transaction includes consulting an external database. (Column 9, lines 57-62, "The collection of input information for the system may be effected based upon local resident databases, such as a telemarketer's database, or through use of third party databases, such as credit card or credit worthiness databases")

3-10. Regarding claim 10;

Katz further discloses:

- searching at least one external database for a partial profile or portion thereof which complements a at least one second partial profile of the databank, and between the database and the databank, contracting for the databank to own or represent a right to a first mutually agreed portion of the complementing first partial profile, and substantially thereafter said databank incorporating the agreed portion of the first profile into at least one second partial profile. (Column 9, lines 57-62, "The collection of input information for the system may be effected based upon local resident databases, such as a telemarketer's database, or through use of third party databases, such as credit card or credit worthiness databases, or possibly, a combination of both local and remote databases.") Whereas the combination of data from different databases are assigned credible weight between profiles. Invention uses different databases in the process. The combined data form a new set of credible information on an user.

#### **Pertinent Art**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Scroggie Michael et al (5970469) - consumers based on a consumer purchase history and transmitted to consumers' computers using electronic mail addresses stored in a consumer database
- Foreign: 200023928 WO 4-2000
- NPL: InfoUSA.com Partners With DoubleClick to Sell Advertising on its WEBSITE; Business Wire; New York; April 13, 1999

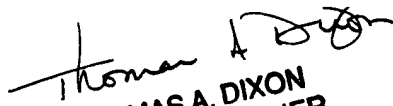
Art Unit: 3629

***Conclusion***

Any communications concerning this communications or earlier communications from the examiner should be directed to Theoplis Stewart whose telephone number is (703) 305-5344. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) - 308-1113.

If in attempts to reach the examiner by phone is unsuccessfully, the examiner's supervisor, John Weiss can be reached at 703-308-2702. Responses to this action should be mailed to:

*Commissioner of Patents and Trademarks*  
Washington, D.C 20231

  
**THOMAS A. DIXON**  
**PRIMARY EXAMINER**

12-11-02

T.E.S

TS